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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,413	04/25/2001	Tony M. Pearce	5066 P	9340

7590 07/14/2004

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EXAMINER

HO, THOMAS Y

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/843,413

### Applicant(s)

PEARCE, TONY M.

### Examiner

Thomas Y Ho

### Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Status of Claims*

Claims 4-11 are pending. Claims 1-3 have been withdrawn or cancelled.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenawalt US4528705 in view of Pearce US5749111, and further in view of cited case law.**

As to claim 4, Greenawalt705 discloses, a contourable orthopedic pillow comprising: an inflatable bladder 34, a resilient material 12 covering both the top and bottom of said bladder, said resilient material being sufficiently flexible to accommodate inflation of said bladder, wherein said resilient material has top/bottom symmetry so that the pillow can be turned over for use on either side, wherein said bladder may be inflated and deflated to adjust contour of the pillow from nearly flat to fully contoured, wherein contour of the pillow is adjustable in discrete increments by inflating said bladder in discrete increments, and a padding layer 40 covering at least a portion of said resilient material.

The difference between the claim and Greenawalt705 is the claim recites, a padding layer covering on a base, the covering including a yieldable cushioning element having a flexible resilient gel cushioning media having shape memory and being substantially solid and non-flowable at temperatures below 130 degrees Fahrenheit, wherein the cushioning element includes

Art Unit: 3677

a quantity of gel cushioning media formed to have a top a bottom and an outer periphery, said cushioning media being compressible so that it will deform under the compressive force of a cushioned object, a plurality of hollow columns formed in said cushioning media, each of said columns having a longitudinal axis along its length each of said columns having a column wall which defines a column interior, and each of said columns having two ends, each of said column ends being positioned at two different points of said column axis, at least one of said columns being positioned generally parallel to the direction of a compressive force exerted on the cushioning element by a cushioned object, at least one of said column walls being capable of buckling beneath a protuberance.

Pearce111 teaches a padding layer covering 205 on a base 301, the covering including a yieldable cushioning element 205 having a flexible resilient gel cushioning media having shape memory and being substantially solid and non-flowable at temperatures below 130 degrees Fahrenheit (col.6, ln.5-20), wherein the cushioning element includes a quantity of gel cushioning media formed to have a top a bottom and an outer periphery, said cushioning media being compressible so that it will deform under the compressive force of a cushioned object, a plurality of hollow columns 206 formed in said cushioning media, each of said columns having a longitudinal axis along its length each of said columns having a column wall which defines a column interior, and each of said columns having two ends, each of said column ends being positioned at two different points of said column axis, at least one of said columns being positioned generally parallel to the direction of a compressive force exerted on the cushioning element by a cushioned object, at least one of said column walls being capable of buckling beneath a protuberance (see Figures 2-3).

Art Unit: 3677

As to claim 7, Greenawalt705 discloses, a contourable orthopedic pillow comprising: a bladder 34 that may be inflated by placement of a gas therein, and a resilient material 12 overlaying both the top and bottom of said bladder, said resilient material covering being sufficiently flexible to accommodate inflation of said bladder, wherein contour of the pillow is adjustable from nearly flat to fully contoured by inflation of said bladder, wherein contour of the pillow is adjustable in discrete increments, and a padding layer 40 covering at least a portion of said resilient material.

Pearce111 teaches, a padding layer covering including a yieldable cushioning element 205 having a flexible, resilient, gel cushioning media having shape memory and being substantially solid and non-flowable at temperatures below 130 degrees Fahrenheit (col.6, ln.5-20), wherein the cushioning element includes a quantity of gel cushioning media formed to have a top, a bottom, and an outer periphery, said cushioning media being compressible so that it will deform under the compressive force of a cushioned object, a plurality of hollow columns 206 formed in said cushioning media, each of said columns having a longitudinal axis along its length, each of said columns having a column wall which defines a column interior, and each of said columns having two ends, each of said column ends being positioned at two different points of said column axis, at least one of said columns being positioned generally parallel to the direction of a compressive force exerted on the cushioning element by a cushioned object, at least one of said column walls being capable of buckling beneath a protuberance (see Figures 2-3).

**Claims 5 and 8 are rejected under 35 USC 103(a) as being obvious over Greenawalt US4528705 in view of Pearce US5749111, and further in view of cited case law, and further**

Art Unit: 3677

**in view of Greenawalt US4501034.**

As to claim 5, the difference between the claim and Greenawalt705 is the claim recites, further comprising a second inflatable bladder, which may be inflated to further adjust orthopedic contour of the pillow.

Greenawalt034 discloses an inflatable pillow similar to that of Greenawalt705. In addition, Greenawalt034 further teaches a first inflatable bladder 24 and a second inflatable bladder 32. It would have been obvious to one of ordinary skill in the art, having the disclosures of Greenawalt705 and Greenawalt034 before him at the time the invention was made, to modify the inflatable pillow of Greenawalt705 to have a second inflatable bladder of Greenawalt304, to obtain an inflatable pillow having first and second inflatable bladders. One would have been motivated to make such a combination because the ability to increase the possibilities of firmness variation would have been achieved, as taught by Greenawalt034 (col.2, ln.50-60).

As to claim 8, Greenawalt034 teaches, further comprising a second inflatable bladder 32 which may be inflated to further adjust orthopedic contour of the pillow.

**Claims 6 and 9 are rejected under 35 USC 103(a) as being obvious over Greenawalt US4528705 in view of Pearce US5749111, and further in view of cited case law, and further in view of Pekar US5372487.**

As to claim 6, Greenawalt705 discloses, further comprising: a pump 38 integral to the pillow (see Figure 1), the pump including a pump bladder having bladder walls, an orifice on a bladder wall through which a gas may travel as desired, resilient means located in said pump bladder, said resilient means serving to re-expand said pump bladder after it has been contracted by a squeezing force, and a one-way valve between said pump bladder and said inflatable gas-

Art Unit: 3677

containing bladder to permit the pump to force gas into said inflatable gas-containing bladder, and a bleed valve on said inflatable gas-containing bladder for permitting gas to escape therefrom.

Greenawalt705 discloses a bulb type pump used for checking blood pressure. Although the exact details are not disclosed, it is old and well known that pumps having the structures and use disclosed do in fact possess the claimed elements. In addition, another old and well-known pump for an inflatable cushion is disclosed by Pekar487, and is used as further evidence to show that inflatable cushions have pumps as claimed. It would have been obvious to one of ordinary skill in the art, having the disclosures of Greenawalt705 and Pekar487 before him at the time the invention was made, to include in the pump of Greenawalt705, the elements of the pump in Pekar487, to form a means to selectively inflate and deflate the cushion that is integral to the bladder (col.3, ln.35-40).

As to claim 9, Greenawalt705 discloses, further comprising a pump 38 integral to the pillow (see Figure 1), the pump including a pump bladder having bladder walls, an orifice on a bladder wall through which a gas may travel as desired, resilient means located in said pump bladder, said resilient means serving to re-expand said pump bladder after it has been contracted by a squeezing force, and a one-way valve between said pump bladder and said inflatable gas-containing bladder to permit the pump to force gas into said inflatable gas-containing bladder, and a bleed valve on said inflatable gas-containing bladder for permitting gas to escape therefrom.

Pekar487 also teaches the claimed pump elements.

**Claim 10 is rejected under 35 USC 103(a) as being obvious over Greenawalt**

Art Unit: 3677

**US4528705 in view of Pearce US5749111, and further in view of cited case law, and further in view of Walpin US6182312.**

As to claim 10, Greenawalt705 discloses, wherein said resilient material covering 12 is made of urethane (col.2, ln.15-20).

The difference between the claim and Greenawalt705 is the claim recites, the material is selected from the group consisting of polyurethane foam, memory foam, latex foam rubber, fiber batting, buckling elastomers, and a resilient material that includes discontinuous pieces of flexible material joined together by low-durometer, high elongation elastomeric material.

Walpin312 discloses a cushion similar to that of Greenawalt705. In addition, Walpin312 further teaches to use the material memory foam (col.4, ln.1-10) for the resilient material covering 50. It would have been obvious to one of ordinary skill in the art, having the disclosures of Greenawalt705 and Walpin312 before him at the time the invention was made, to modify the urethane resilient material covering of Greenawalt705 to be made of memory foam, as in Walpin312, to obtain a resilient material covering made of memory foam. One would have been motivated to make such a combination because the ability to conform to a user's head and neck region would have been achieved, as taught by Walpin312 (col.4, ln.1-10). In addition, the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

**Claim 11 is rejected under 35 USC 103(a) as being obvious over Greenawalt US4528705 in view of Pearce US5749111, and further in view of cited case law, and further in view of Walpin US6182312, and further in view of Pekar US5372487.**



Art Unit: 3677

As to claim 11, Greenawalt705 discloses, further comprising: a pump 38 integral to the pillow (see Figure 1), the pump including a pump bladder having bladder walls, an orifice on a bladder wall through which a gas may travel as desired, resilient means located in said pump bladder, said resilient means serving to re-expand said pump bladder after it has been contracted by a squeezing force, and a one-way valve between said pump bladder and said inflatable gas-containing bladder to permit the pump to force gas into said inflatable gas-containing bladder, and a bleed valve on said inflatable gas-containing bladder for permitting gas to escape therefrom.

Pekar487 also teaches the claimed pump elements.

#### ***Response to Amendment***

The declaration under 37 CFR 1.132 filed 10/2/03 is insufficient to overcome the rejection of claims 4-11 based upon the cited references as set forth in the last Office action because: Applicant does not establish a nexus between the claimed invention and evidence of commercial success (MPEP 716.03).

Applicant submitted a declaration concerning the licensing of the invention of the patent claims to a third party for several hundred thousand dollars, and periodic royalty payments on products made using the invention. Applicant contends that these payments represent both commercial success of the invention and respect for the patent application in the field, and this rebuts rejections using obviousness.

In response to this argument, Applicant is directed to MPEP section 716.03 concerning commercial success. This section states that Applicant bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success. This nexus has not

Art Unit: 3677

been established by the declaration from 10/2/03. MPEP 716.03(b) states that "evidence of licensing is a secondary consideration which must be carefully appraised as to its evidentiary value because licensing programs may succeed for reasons unrelated to the unobviousness of the product or process, e.g., license is mutually beneficial or less expensive than defending infringement suits". Further, to support nonobviousness, the success cannot be the result of consumption by purchasers normally tied to applicant or assignee, and it is unclear whether Applicant or assignee of the instant application has any ties to the licensees. Applicant must also prove that the claimed features were responsible for the commercial success of an article to give the evidence substantial weight. Applicant argues in the latest response (pg. 5) that "if the invention in the patent claims were obvious, then the licensees would have combined (cited references)...to make the invention rather than paying...for rights in the invention," and so the payments represent both commercial success of the invention and respect for the patent application in the field. However, MPEP 716.03(b) states "Inventor's opinion as to the purchaser's reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention." Finally, Applicant's declaration fails to show gross sales figures including market share, time period in which the product was sold, and normal sales. The evidence provided to show non-obviousness is therefore unconvincing.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

Art Unit: 3677

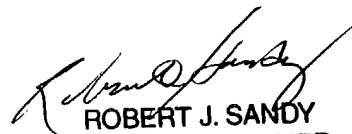
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Y Ho whose telephone number is (703)305-4556. The examiner can normally be reached on M-F 10:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J Swann can be reached on (703)306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TYH

  
ROBERT J. SANDY  
PRIMARY EXAMINER